

REMARKS/ARGUMENTS

The Final Office Action of February 10, 2004, has been carefully reviewed and these remarks are responsive thereto. Reconsideration and allowance of the instant application are respectfully requested. Claims 1, 36-37, 41, 45, and 57 have been amended. Claims 1-6, 8-9, 12-14, 20-25, 27-30, 36-37, 39, 41-57 remain pending.

Applicants thank the Examiner for the indication that claims 1-6, 8-9, 12-14, 20-25, 27-30, and 45-56 are allowable over the art of record. Claims 1, 37, 41 and 45 have been amended to correct minor typographical problems.

Claims 36-37, 39, 41-44, and 57 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Cassorla et al. (U.S. Patent No. 5,146,552, hereinafter referred to as *Cassorla*) and Shwartz et al. (U.S. Patent No. 6,243,071, hereinafter referred to as *Shwartz*). Applicants respectfully traverse this rejection.

Applicants' amended independent claim 36 recites, among other features, "a second data field comprising information identifying a user-defined part of the document being marked by the data structure; and a third data field comprising information regarding user-defined properties of a visual indicator corresponding to the data structure, wherein the visual indicator is configured to be displayed partially outside of the document and with the user-defined part of the document." In *Cassorla*, based upon coordinates 56, a *Cassorla* "bookmark" defines a last placed read notation and merely opens the electronic book to that location when the user decides to continue reading the book. However, there is clearly no visual indicator displayed at least partially outside of the document. Indeed, *Cassorla* alone fails to teach or suggest every feature of Applicants' amended claim 36. Further, *Cassorla* in combination with *Shwartz* fails to teach or suggest every feature of Applicants' claim 36.

Applicants' claim 36 is patentably distinct from the *Shwartz* element, bookmark 340. Figure 17 of *Shwartz* describes the bookmark 340 element. As shown in Figure 17, the bookmark 340 is a separate element from the underlying page. Bookmark element 340 is contained within the "navigation" dialogue box of Figure 17. As shown in Figure 17, when a user chooses element 340, the referenced page, in this case page 3, is displayed without any form

of a visual indicator representative of a bookmark or placemark that is configured to be displayed partially outside of the referenced page.

Further, the Action alleges that, “Shwarts et al do show data field information based on the user modifiable properties for easy user navigation.” For support in this allegation, the Action relies on column 18, lines 20-45 and 50-65 of *Shwarts*. Yet, the cited portion of *Shwarts* fails to teach or suggest, “a third data field comprising information regarding user-defined properties of a visual indicator corresponding to the data structure,” as recited, among other features, in Applicants’ claim 36. Column 18, lines 20-45 and 50-65 of *Shwarts* describe the process by which selection of the bookmark button 80 is processed. (Col. 18, 20-21). Specifically, the cited portions describe creation of a thumbnail picture of the page (bookmark 340), in a separate dialog box from the actual document. The cited portions clearly fail to teach or suggest, “a third data field comprising information regarding user-defined properties of a visual indicator corresponding to the data structure,” as recited, among other features, in Applicants’ claim 36.

Thus, for at least the above-stated reasons, *Cassorla* and *Shwarts*, either alone or in combination, fail to teach or suggest every feature of Applicants’ independent claim 36.

Claims 37, 39, and 41-44, which ultimately depend from claim 36, are patentably distinct from *Cassorla* and *Shwarts*, either alone or in combination, for the reasons set forth above, and further in view of the additional advantageous features recited therein.

Applicants’ independent claim 57 has been amended to include many of the features recited in Applicants’ allowed independent claim 1. As such, Applicants’ independent claim 57 is patentably distinct over the combination of *Cassorla* and *Shwarts* for at least the same reasons as Applicants’ allowed claim 1 and further in view of the novel features recited therein.

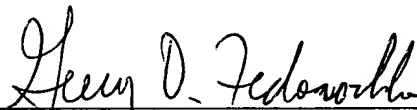
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CONCLUSION

All rejections having been addressed, Applicants respectfully submit that the instant application is in condition for allowance, and respectfully solicit prompt notification of the same. Should the Examiner find that a telephonic or personal interview would expedite passage to issue of the present application, the Examiner is encouraged to contact the undersigned attorney at the telephone number indicated below. No fee is believed due, however, if any fees are required or if an overpayment has been made the Commissioner is authorized to charge or credit Deposit Account No. 19-0733. Applicants look forward to passage to issue of the present application at the earliest convenience of the Office.

Respectfully submitted,
BANNER & WITCOFF, LTD.

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By: 
Gary D. Fedorochko
Registration No. 35,509

1001 G Street, N.W.
Eleventh Floor
Washington, D.C. 20001-4597
(202) 824-3000